

**REMARKS**

In the Office Action dated May 23, 2005, claims 1-14 were presented for examination. Claims 1-14 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Claims 1-9 were rejection under 35 U.S.C. §102(b) as being anticipated by *Smith*, U.S. Patent No. 5,832,068. Claims 1, 5, 6, 9, and 13 were rejected under 35 U.S.C. §102(a) as being anticipated by *Applicant's Admitted Prior Art (AAPA)*. Claims 2-4, 7, 8, 10-12, and 14 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Smith* in view of *Applicant's Admitted Prior Art (AAPA)*.

The following remarks are provided in support of the pending claims and responsive to the Office Action of May 23, 2005 for the pending application.

**I. Rejection of Claim 1-14 under 35 U.S.C. §112, second paragraph**

In the Office Action dated May 23, 2005, the Examiner assigned to the application rejected claims 1-14 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. More specifically, the Examiner has alleged that the term "organizing" in the preamble is indefinite. Applicant has removed this term from the claims, and replaced this term with the word "merging". Support for the term "merging" this is found on page 1, line 3. The Examiner further alleges that the term "switching" is indefinite. Applicant has removed the term "switching" and replaced this with the term "processing". Support for the term "processing" is found on page 11, line 49. Finally, the Examiner alleges that the term "odd number" is indefinite. It is intuitive that there are multiple input streams, and therefore an odd number of input streams is greater than one. To clarify this element, Applicant has amended the claims to specifically recite this limitation. Accordingly, in view of the amendments to the claims submitted herewith, Applicant respectfully requests that the Examiner remove the rejection of claims 1-14 under 35 U.S.C. §112, second paragraph.

**II. Rejection of claims 1 and 9 under 35 U.S.C. §102(b)**

In the Office Action dated May 23, 2005, the Examiner assigned to the application rejected claims 1 and 9 under 35 U.S.C. §102(b) as being anticipated by *Smith*. As noted in the Response to the Second Office Action, *Smith* creates a secondary list known as an exclusion list in response to a duplicate item. As noted in Col. 8, lines 50-52 of *Smith*, in response to a duplicate item “the retrieved record is discarded and not processed.” Applicant’s invention functions on a different principal. Applicant processes data from a second input stream in response to a duplicate status identifier. Applicant does not create or transfer data items to an exclusion list, nor does Applicant discard records, as taught by *Smith*. It is clear that *Smith* does not teach all of the elements as presented in Applicant’s amended claims 1 and 9. Accordingly, Applicant respectfully requests the Examiner to remove the rejection of claims 1 and 9, as amended.

**III. Rejection of claims 1, 5, 6, 9, and 13 under 35 U.S.C. §102(a)**

In the Office Action data May 23, 2005, the Examiner assigned to the application rejected claims 1, 5, 6, and 9 under 35 U.S.C. §102(a) as being anticipated by Applicants Admitted Prior Art (AAPA). As noted in the Response to the Second Office Action, the AAPA relates to merging two or more input data streams into a single sorted output stream. As indicated at the paragraph beginning at page 2, line 11, there are shortcomings with the prior art in that it only evenly consumes from two or more input stream when the number of input streams is an even power of 2. Applicant’s amended claim , which is supported in the specification, places a limitation to avoid exhausting one input stream over another even when the number of input streams is not an even power of 2. Accordingly, since the AAPA fails to illustrate an equitable solution for managing input streams containing duplicate data items, Applicant respectfully requests the Examiner to remove the rejection of claims 1, 5, 6, 9, and 13.

**IV. Rejection of claims 2-4, 7, 8, 10-12, and 14 under 35 U.S.C. §103(a)**

In the Office Action dated May 23, 2005, the Examiner assigned to the application rejected claims 2-4, 7, 8, 10-12, and 14 under 35 U.S.C. §103(a) as being unpatentable over *Smith*, U.S. Patent No. 5,832,068, in view of *Applicants Admitted Prior Art (AAPA)*.

The comments pertaining to *AAPA* and *Smith* in the Response to the First Office Action, Second Office Action, and above are hereby incorporated by reference.

There is no teaching in *AAPA* for an indicator to be an integer corresponding to one of four values. At most, *AAPA* teaches only three of the four values, and an algorithm responsive to the three identified values. As noted by the Examiner in Section III, "0 is equal or duplicate". See Second Office Action, page 4. The *Smith* patent teaches identifying duplicate records. See Fig. 3. However, whether considered individually or combined, the *AAPA* and *Smith* patent do not teach the four integer options as claimed by Applicant. "To establish a *prima facie* case of obviousness . . . the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure." MPEP §2142, citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). *AAPA* does not teach the four integer options as claimed by Applicant. In fact, at most *AAPA* may only be interpreted to include three of the four integer options. Similarly, *Smith* teaches the duplicate integer option, but does not teach the four options claimed by Applicant.

In order to apply *AAPA* to Applicant's pending application, the *AAPA* must be modified and reconfigured to support the four integer options of Applicant. However, utilizing Applicant's four integer options goes against the teachings of *AAPA*. "Although a prior art device 'may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so.' " MPEP §2143.01 (citing *In re Mills*, 916 F.2d 680, 682, 16 USPQ2d 1430 (Fed. Cir. 1990). *AAPA* does not teach or suggest the four integer options as claimed by Applicant. To read *AAPA* as providing or supporting all four of these integer options would require a modification to the invention of *AAPA* not envisioned or required. Similarly, to read *Smith* as providing the fourth option not taught in the *AAPA* would require a modification to the invention of *Smith* not envisioned or required. *Smith* does not teach the fourth integer missing from *AAPA*. *Smith* teaches identifying duplicate records. As noted by the Examiner, the duplicate integer is taught in the *AAPA*, it is the *AAPA*'s response to the

duplicate integer that differs from Applicant. The only suggestion for each of the four integer options is derived from Applicant's invention. Absent Applicant's invention, there is no suggestion or motivation within *AAPA* or *Smith* for such modifications. "It is impermissible to use the claimed invention as an instructions manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious." *In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780 (Fed. Cir. 1992) (citing *In re Gorman*, 933 F.2d 982, 987 (Fed. Cir. 1991)). Yet this is the very process that the Examiner has attempted to undertake. The entirety of Applicant's invention is greater than the sum of the parts that comprise the novelty of the invention. "[T]he linchpin is not whether the individual components of the patent were obvious at the time of the invention, but whether the aggregation produced a new or different result or achieved a synergistic effect." *Id.* (Citing *Continental Oil Co. v. Cole*, 634 F.2d 188, 197 (5<sup>th</sup> Cir. 1981)).

Even if as a general matter it would be trivial to combine the teachings of *AAPA* with the teachings of *Smith*, it would not necessarily be obvious to combine them in view of one another. There must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. See MPEP §2143. "The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in the applicant's disclosure." MPEP §2143, (citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)). Here *AAPA* teaches the use of three options. However, as noted by the Examiner, *AAPA* fails to teach or suggest the use of four options. While *Smith* teaches identification of duplicate records, duplicate is one of the four integers identified in the *AAPA* - it is not the missing option, there is no suggestion of employing a four integer option. "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art suggests the desirability of the combination." MPEP §2143.01 (citing *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)). The only suggestion for the combination of elements that form Applicant's invention is found in Applicant's invention. Accordingly, the Applicant respectfully submits that claims 2-4, 7, 8, 10-12, and 14 would not have been obvious for the above outlined reasons and allowance of

these claims is respectfully requested.

For the reasons outlined above, withdrawal of the rejection of record and an allowance of this application are respectfully requested.

Respectfully submitted,

By: \_\_\_\_\_

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